

Atty Dkt: JPC001.C1

REMARKS

This is intended as a full and complete response to the Final Office Action dated September 6, 2005, having a shortened statutory period for response set to expire on December 6, 2005. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-3, 5-10, 12-19 and 21-71 remain pending in the application upon entry of this response. Claims 15-19, 21-28, 31-43, 50, 55-62 and 66-71 have been found allowable by the Examiner. Claims 1-3, 5-10, 12-14, 29-30, 44-49, 51-54 and 63-65 stand rejected by the Examiner. Claims 1, 8, 12, 29-30, 44, 51, 54 and 63-64 have been amended. Reconsideration of the rejected claims is requested for reason presented below.

Claims 1-3, 5, 7-10, 12, 14, 29-36, 44-47, 51-54 and 63-65 stand rejected under 35 U.S.C. § 102(a) as being anticipated over Kitamura, JP 2000-082580A, herein referred to as *Kitamura*. The Applicant notes that *Kitamura* is only available as prior art under 35 U.S.C. § 102(a) as of its publication date, March 21, 2000. The Applicant submitted a declaration under 37 C.F.R. § 1.131 in the last Response to Office Action. As shown in the declaration under 37 C.F.R. § 1.131, possession of the invention as presently claimed by the Applicant occurred prior to the publication date of *Kitamura*, and therefore, *Kitamura* cannot be relied upon by the Examiner as prior art. The Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5, 7-10, 12, 14, 29-36, 44-47, 51-54 and 63-65 in view of *Kitamura*.

Support for claims 1-3, 5, 7-10, 12, 14, 29-36, 44-47, 51-54 and 63-65 may be found throughout the 1.131 declaration including Exhibits A and B and statements of the Applicant therein. The examples described throughout the 1.131 declaration including Exhibits A and B and statements of the Applicant were reduced to practice prior to March 21, 2000, as stated in the 1.131 declaration. Therefore, the examples provide evidence that the Applicant had possession of the claimed invention prior to March 21, 2000.

Claims 6, 13 and 48-49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Kitamura* in view of Ueki, JP 10314092A, herein referred to as *Ueki*. As shown in the declaration under 37 C.F.R. § 1.131, possession of the invention as presently

Atty Dkt: JPC001.C1

claimed by the Applicant occurred prior to the publication date of *Kitamura*, and therefore, *Kitamura* cannot be relied upon by the Examiner as prior art. The Applicant notes that *Ueki* is only available as prior art under 35 U.S.C. § 102(a) as of its publication date, December 2, 1998. Also shown in the declaration under 37 C.F.R. § 1.131, possession of the invention as presently claimed by the Applicant occurred prior to the publication date of *Ueki*, and therefore, *Ueki* cannot be relied upon by the Examiner as prior art. The Applicant respectfully requests withdrawal of the rejection of claims 6, 13 and 48-49 over *Kitamura* in view of *Ueki*.

Support for claims 6, 13 and 48-49 may be found throughout the 1.131 declaration including Exhibits A and B and statements of the Applicant therein. The examples described throughout the 1.131 declaration including Exhibits A and B and statements of the Applicant were reduced to practice prior to December 2, 1998, as stated in the 1.131 declaration. Therefore, the examples provide evidence that the Applicant had possession of the claimed invention prior to December 2, 1998.

The Applicant refers the Examiner to several cases related to 37 CFR 1.131 affidavits. A "37 CFR 1.131 affidavit *is not insufficient merely because it does not show the identical disclosure* of the reference(s) or the identical subject matter involved in the activity relied upon. If the affidavit contains *facts showing a completion of the invention commensurate* with the extent of the invention as claimed is shown in the reference or activity, the affidavit or *declaration is sufficient*, whether or not it is a showing of the identical disclosure of the reference or the identical subject matter involved in the activity. See *In re Wakefield*, 422 F.2d 897, 164 USPQ 636 (CCPA 1970)." (*emphasis added*) (MPEP 715.02). The District Court found that the appellant overcame the reference even though "[i]t was the examiner's position that the product shown in appellant's Rule 131 affidavits 'is not the same polymer disclosed by Home and does not support the broad claim.'" (*In re Wakefield*, page 639).

Further, the court in *Spiller* found "[e]ven if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of

Atty Dkt: JPC001.C1

applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s)." (MPEP 715.02, citing *In re Spiller*, 500 F.2d 1170, 182 USPQ 614 (CCPA 1974).

The Examiner concedes that the "apparatus and processes were conceived and reduced to practice prior to March 21, 2001," however, the Examiner asserts that the Applicant's prior responses did not overcome the rejections since "the Exhibit A does not provide support for the **deformed enclosure when heated**." (*emphasis added*) (Final Office Action, dated 06/22/2005, p. 3). During a telephone interview with the Applicant, the Examiner further stated that *Kitamura* discloses a "deformed enclosure when heated" and that Exhibit A lacked support to overcome the rejection. The Applicant respectively traverses the rejection.

The Applicant asserts that the Examiner is disregarding the District Court's decision that an "affidavit is not insufficient merely because it does not show the identical disclosure of the reference(s)." (*In re Wakefield*, page 636). Exhibit A alone provides "facts showing a completion of the invention commensurate" regardless if Exhibit A provides or does not provide support for a "deformed enclosure when heated," as asserted by the Examiner.

Support for the previously claimed element "enclosure is deformable," as well as for "separable," "severable" or "breakable," may be found throughout Exhibit A. For example, "tear-off membrane seal" is disclosed paragraphs 5, 6, 8, 10 and 13. In another example, "tear-off cover" is disclosed in paragraph 5. In another example, "cut through membrane seal" is disclosed in paragraph 9. In another example, "cut through membrane" is disclosed in paragraph 14. In another example, "[t]he **product may be opened** with a fork or knife **plunged** into sponge 30 and **through membrane 25**" is disclosed in paragraph 14. Each of the aforementioned examples was reduced to practice prior to March 21, 2000, as stated in the 1.131 declaration. The examples provide evidence that the Applicant had possession of the claimed invention prior to March 21, 2000. Since the examples provide "facts showing a completion of the invention commensurate," as determined by the District Court, the "declaration is sufficient" to overcome the Examiner's rejection. (*In re Wakefield*, page 636).

In order to move prosecution forward, the Applicant has amended the claims to more broadly recite "separable," "severable" or "breakable" instead of "deformable" for

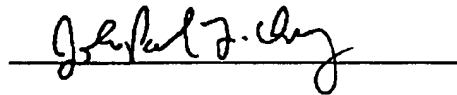
Atty Dkt: JPC001.C1

describing enclosures. The amended claims have a broader claim scope which includes a "deformable" enclosure.

Having addressed all issues set out in the Office Action, the Applicant respectfully submits that the claims are in condition for allowance and respectfully request that the claims be allowed.

If the Examiner would like to discuss this response further, please feel free to call the Applicant during working hours at 713.577.4828.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "John-Paul F. Cherry", is written over a horizontal line.

John-Paul F. Cherry
3203 Oak Bough Ln.
Missouri City, TX 77459-4655
Telephone: 617.233.4415
Facsimile: 713.623.4846